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Exxon Chemical Patents Inc. v. Lubrizol Corp. (CA FC) 37 USPQ2d 1767 (2/23/1996)

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Exxon Chemical Patents Inc. v. Lubrizol Corp.

**U.S. Court of Appeals Federal Circuit
37 USPQ2d 1767**

**Decided February 23, 1996
Nos. 93-1275, 94-1309**

Headnotes

PATENTS

1. Patent construction -- Claims -- Broad or narrow (§ 125.1303)

Petition for rehearing is denied, and suggestion for rehearing in banc is declined, following decision holding that claims for engine oil composition are drawn to specific product having particularly defined ingredients, and do not merely describe "recipe" for making whatever product results from use of specified ingredients, that composition is not time-limited to final product, and that accused product therefore infringes if it contains, at some time, each of claimed ingredients in amounts specifically claimed.

Particular patents -- Chemical -- Lubricating oil

4,867,890, Colclough, Gibson, and Marsh, lubricating oil compositions containing ashless dispersant, zinc dihydrocarbyldithiophosphate, metal detergent and a copper compound, petition for rehearing and suggestion for rehearing in banc of decision reversing judgment of literal infringement is denied.

Case History and Disposition:

} Appeal from the U.S.District Court for the Southern District of Texas, Black, C.J.

Action by Exxon Chemical Patents Inc., Exxon Corp., and Exxon Research and Engineering Co. against Lubrizol Corp. for patent infringement. From judgment of willful infringement entered on jury verdict, defendant appeals. Reversed (35 USPQ2d 1801). On combined petition for rehearing and suggestion for rehearing in banc filed by plaintiffs-appellees. Petition for rehearing denied; suggestion for rehearing in banc declined; Mayer, J., concurring in separate opinion; Clevenger, J., with whom Plager, J., joins, concurring in separate opinion; Newman, J., dissenting in separate opinion.

Prior decision: 19 USPQ2d 1061 .

Attorneys:

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S. Leslie Misrock, of Pennie & Edmonds, New York, N.Y.; Timothy B. Dyk, of Jones, Day, Reavis & Pogue, Washington; George J. Moscarino and John W. Edwards II, of Jones, Day, Reavis & Pogue, Cleveland, Ohio; Stanton T. Lawrence III, of Pennie & Edmonds, Washington, D.C., and Kenneth R. Adams, of Jones, Day, Reavis & Pogue, Dallas, Texas, for defendant-appellant

Opinion Text

Opinion By:

Mayer, J., concurring.

ORDER

[1] A combined petition for rehearing and suggestion for rehearing in banc having been filed by the appellee, and a response thereto having been invited by the court and filed by the appellant, and the petition for rehearing having been referred to and acted upon by the panel that heard the appeal, and, thereafter, the suggestion for rehearing in banc, the response and a reply to the response, having been referred to the judges authorized to request a poll whether to rehear the appeal in banc, and a poll having been requested, taken, and failed, it is

ORDERED that the petition for rehearing be, and the same hereby is DENIED; and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

This is another example of the predicted mischief of *Markman v. Westview*

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Instruments, Inc. , 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir.), *cert. granted* , 116 S. Ct. 40 (1995). Two judges have divined an interpretation of the claim that occurred to no one else in this extensive litigation. None of the parties or the trial court offered the interpretation that these two judges chose, and none of the extensive extrinsic evidence about how those skilled in the art would understand the claim supports it. After *Markman* , apparently the meaning of a claim has very little to do with the parties' theories of the case and the record made in support, and everything to do with what at least two judges here prefer regardless of the record.

Clevenger, J., with whom Plager, J., joins, concurring in the court's denial of the petition for rehearing in banc.

Because more than twelve thousand pages will separate the decision of the court in this case, found at 64 F.3d 1553 (Fed. Cir. 1995), from the comments of Judges Newman and Mayer, we shall quickly bridge the gap to ease the mind of any concerned reader.

Judge Newman's general views on how to read the claims in suit reduce themselves to a simple proposition. Although Exxon's patent is on a specifically defined chemical product (a "lubricating oil composition suitable as a crankcase lubricant"), Judge Newman treats Exxon's claims differently, as if they were drawn to a formula (or recipe) for making whatever product results from mixing the ingredients named in the formula. Were such the case, Exxon would have won on its proofs in this case. Instead, Exxon sued Lubrizol on a chemical product claim. To win, Exxon had to prove that Lubrizol's product contains, in the specific amounts stated in the patent, the chemicals named in Exxon's patented formula. Although Exxon proved that Lubrizol's product contained the named chemicals, it failed to prove that those chemicals are present in Lubrizol's product in the specific required amounts. So Exxon lost.

The basic claim interpretation theory adopted by the court was put forth by Lubrizol in its defense to Exxon's suit, as explained in the court's opinion, which amply demonstrates the respects in which our colleagues have misread the opinion and the record in this case.

Newman, J., dissenting from the denial of rehearing en banc.

The court's decision in the case of *Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 35 USPQ2d 1801 (Fed. Cir. 1995), creates important new law governing the claiming of chemical compositions. Adopted by split panel decision, it is gravely incorrect. It is incorrect as a matter of law, as a matter of chemistry, and as a matter of patent practice. The panel majority's new rule of "claim construction" will cast a cloud upon many thousands of existing patents, and major classes of chemical invention will confront unclear, unnecessary, confusing, expensive, and perhaps impossible scientific requirements.

The panel majority holds that a claim to a chemical formulation composition can not be infringed if there is interaction between any of the ingredients after they are added to the composition, such that any ingredient changes in chemical form or ratio from that listed in the claim. Thus any chemical change or interaction within the composition, even loose "complexing" as appears to happen between ingredients of this composition, renders the claim useless. The panel majority holds that it does not matter that the Lubrizol composition is identical to the claimed composition: the purported changes inside the composition after it is made is held by the panel majority to negate infringement.

This is a new and incorrect rule of claim construction. It is not necessary to state the myriad interactive changes that occur in chemical solutions or dispersions, in order to describe this lubricant formulation clearly and unambiguously. Many thousands of chemical patents are written in the simple combination style here found fatally wanting. Consider Exxon's claim 1 shown in the margin, 1 a straightforward list of the

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ingredients of the composition, all of which are known lubricating oil additives except the copper component, which is listed at "D" in the claim.

Most or all chemicals interact to some extent in solution, wherein ions and molecules rearrange based on forces of various kinds. Under the court's new law, table salt dissolved in water will not be an adequate description of the composition for infringement purposes, since the sodium chloride molecule no longer "exists": in dissolution the sodium and chloride ions will have broken their bonds to each other, in interaction with molecules of water. For the Exxon lubricant composition the interactions in the pot were exceedingly complex. However, like salt in water, there is no uncertainty as to what was made and what was infringed. When the invention is adequately described and claimed by listing the ingredients of the composition, and is understood by persons of skill in the field of the invention, the law demands no more. To require inventors to identify and include in their claims the chemical interaction products formed in such a complex mixture is not necessary in order distinctly to state what

the inventor regards as his invention. 35 U.S.C. Section 112 Para.2:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The court's holding that a chemical composition claim that is written by listing the ingredients can not be enforced against the identical composition made by combining the identical ingredients in the identical ratio, unless none of the ingredients interact when they are placed together, is simply bad law. It is without precedent, and it is contrary to the way that chemical formulation composition claims are understood within the chemical and the legal communities. This *sua sponte* transformation of the patent law does not bode well for this court's implementation of its *Markman* role as *de novo* construer of patent claims.

Despite the serious disruption of chemical patent-dependent activity flowing from this decision and the massive taint upon existing property rights, the court has declined *en banc* review. Thus I write to explain why I believe that the panel majority has made an error of major consequence, an error that transcends the interests of these parties and this patent.

Chemical Formulation Compositions Are Correctly Claimed by Their Ingredients The standard way of claiming chemical compositions is by their ingredients. Naming the chemicals and their amounts is the clearest, most accurate, and most comprehensible way of describing such inventions. Often there is no other way of describing chemical

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compositions. In Robert C. Faber, *Landis on Mechanics of Patent Claim Drafting* (3d ed. 1990) the author explains the pervasiveness of this type of claim in chemical inventions:

As in the other classes, *most composition claims are combination claims* except where a new compound or molecule per se is claimed.

* * * * Composition of matter claims *list the chemical ingredients (compounds, elements, or radicals) making up the composition* or compound. The ingredients or elements may be claimed narrowly (specific named components), with intermediate scope (a group of similar elements functionally equivalent), or broadly as to function performed, where the prior art permits. Where necessary to novelty, etc., the proportions or other conditions or parameters of the compound are stated, usually in ranges of concentration of ingredients.

Id. at 145, 148 (emphases added). Chemical compositions that are mixtures of ingredients are routinely claimed by listing the ingredients. Such a composition is easy to describe with precision, easy to search and to examine for patentability, easy to understand, and unambiguous in content and scope. Whether there is interaction among the ingredients after they are placed in the container does not affect the specificity of the description of what has been invented. It is not necessary to know what physical or chemical interactions occur in the container in order to describe this invention, which resides in the combination of listed ingredients.

The law requires that the claims "reasonably apprise those skilled in the art both of the utilization and scope of the invention," and that "the language is as precise as the subject matter permits."

Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985). That requirement was plainly met by the claims in suit, for they were written as lubricant formulators would write them and understand them, by listing the ingredients of the composition.

Whatever the scientific nature of the chemical interactions inside the container, the established and probably only way of describing such formulations is by their ingredients. The court creates a scientific burden that is totally unnecessary and perhaps impossible to meet. There was extensive evidence at trial, presented by witnesses on behalf of both Exxon and Lubrizol, concerning what happens when these ingredients are put in the same container. Noted scientists debated the issue. The trial judge recognized that it was not possible to know what was happening inside the pot.

The court's holding that such claims are not infringed if changes occur within the composition after the ingredients are combined, simply means that such compositions can no longer be patented in this way.